<div align="center">**REMARKS**</div>

By this amendment, claims 1-34 are pending, in which claims 2-4, 6, 8, 9, 11, 17, 18, 20, 21, and 30-33 are currently amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment is apparent throughout the originally filed disclosure. Applicants submit that no new matter is introduced.

Objection to claims 15 and 17.

The objections are respectfully traversed.

Claim 15 was objected to as being dependent upon a rejected base claim, but otherwise allowable. Applicants acknowledge, with appreciation, the Examiner's indication that claim 15 contains allowable subject matter. However, Applicants respectfully submit that all pending claims are allowable for at least the following reasons. Accordingly, withdrawal of the objection to claim 15 is solicited.

Claim 17 was objected to as possibly containing grammatical or typographical errors. Applicants respectfully disagree. Claim 17 recites, *inter alia*, "processing the data information indicating the preference for resulting in an order of preference for electronic mail messages for the user." The above quoted features of claim 17 clearly state that the data information indicating the preference is processed to result in "an order of preference" for electronic mail messages for the user. Accordingly, withdrawal of the objection is respectfully requested.

Objection to the Specification.

The Specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Office Action alleges that the specification fails to

clearly define "at least one memory including computer program code for one or more programs" and "[a] non-transitory computer-readable storage medium carrying one or more sequences of one or more instructions which, when executed by one or more processors." Applicants respectfully disagree. For example, page 6, line 32 – page 7, line 22 of the Specification clearly discloses a mobile station, which one of ordinary skill in the art would clearly recognize as being equipped with one or more forms of memory including computer programs code for one or more programs. Additionally, the Specification clearly discloses apparatuses associated with a mail server and a mail agent, as well as a database 210, (see, e.g., page 9, lines 11- 26, page 10, line 33- page 11, line 13, and page 17, line 3 - page 16, line 28, and Figure 2). Similarly, one of ordinary skill in the art would clearly recognize the mail server and the mail agent as being equipped with one or more forms of memory including computer programs code for one or more programs. Accordingly, withdrawal of the objection to the Specification is solicited.

35 U.S.C. § 112, first paragraph, rejection of claims 32, 33, and 34 as failing to comply with the written description requirement.

The rejection is respectfully traversed.

The Office Action alleges that the recited features "at least one memory including computer program code for one or more programs" and "[a] non-transitory computer-readable storage medium carrying one or more sequences of one or more instructions which, when executed by one or more processors" are not described in the Specification. Applicants respectfully disagree. As discussed above with respect to the objection to the specification, the above features are clearly discussed in the Specification, for example, on page 6, line 32 – page 7, line 22, page 9, lines 11- 26, page 10, line 33- page 11, line 13, page 17, line 3 - page 16, line

28, and in Figure 2. Therefore, claims 32-34 comply with the written description requirement and are in compliance with 35 U.S.C. § 112, first paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

35 U.S.C. § 112, first paragraph, rejection of claims 1, 16, and 32-34 as failing to comply with the written description requirement.

This rejection is respectfully traversed.

The Office Action alleges that the recited feature of "determining" is not described in the Specification. Applicants respectfully disagree and respectfully submit that the various actions of determining are clearly disclosed in the Specification. For example, support for the above discussed actions can be found in the Specification at page 6, lines 5-17, page 9, lines 11-26, page 14, line 19 - page 16, line 28.

Thus, Applicants respectfully submit that claims 1, 16, and 32-34 satisfy the written description requirement and are in compliance with 35 U.S.C. § 112, first paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

35 U.S.C. § 112, second paragraph, rejection of Claims 2 and 18 as being indefinite.

This rejection is respectfully traversed.

The Office Action alleges that these claim have improper antecedent basis. Applicants respectfully disagree. However, in an effort to expedite prosecution, and to reduce potential issues for appeal, Applicants have amended claims 2 and 18, as suggested by the Examiner. Thus, Applicants respectfully submit that claims 2 and 18 are definite and are in compliance with

35 U.S.C. § 112, second paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

35 U.S.C. § 103(a) rejection of claims 1, 10-13, 16-17, 26-28, and 31-34 over Schiavone et al. (US 2002/0120600) (Schiavone) in view of Martin (6,606,373) (Martin).

This rejection is respectfully traversed.

With respect to independent claims 1, 17, 32, and 33, Applicants respectfully submit that Schiavone and Martin fail to disclose or render obvious "determining to **indicate**, at the mobile station, the electronic mail message by **a level as to a preference** of the electronic mail message for a user" or "**receiving a list indicating the order of preference** for a plurality of electronic mail messages for the user" as recited in independent claim 1, and as similarly recited in independent claims 17, 32, and 33.

Schiavone, in pertinent part, discloses (emphasis added):

Abstract:
A method for negotiating an electronic mail transaction. An electronic mail message's mail type specifier is identified. A data store stores data specific to the intended recipient. The data store is referenced and the electronic mail message is processed as a function of the mail type specifier and data retrieved from the data store. The mail may be processed at the recipient's mail client device and the information maintained confidential. **The processing may be based upon reference to a rule applicable to that particular message. The rule includes a conditional instruction conditioned upon a result of a logic or other function of recipient profile data**. Alternatively, the processing may provide for modification of the content of the message as a **function of such recipient profile data**. Recipient preferences from multiple recipients may be aggregated and propagated to senders and/or intermediaries to allow for pre-transmission processing of electronic mail messages.

At best, Schiavone merely describes a system and method for rule-based processing of electronic mail messages, wherein **a message type specifier is associated with an electronic mail message and rules are associated with the message type specifiers**.

In the statement of rejection, the Office Action refers to paragraphs [0049], [0024], [0025], [0030], [0055], and [0066] of Schiavone, which are reproduced below (emphasis added):

[0049] As shown in FIG. 3, **the recipient profile data is stored on the recipient's communications device**, an incoming electronic mail message is received, and a **message type specifier associated with the electronic mail message is identified**, as shown at steps 4146 and as described above in reference to FIG. 1 and steps 11-16. For example, consider that the message type specifier identified in step 46 is "ADV". Such a message type specifier indicates that the message is an advertisement or promotional offer from a party with whom the recipient does not have a previous relationship (if a previous relationship exists, such e-mail could be classified or reclassified separately, e.g, as a Customer Relationship Management (CRM) e-mail, a newsletter or promotion from an approved sender, etc.)."

[0024] A message-type specifier of the electronic mail message is next identified, as shown at step 16 of FIG. 1. For example, **the message-type specifier may include a keyword or a seal graphic/image object** (indicating compliance with certain laws, regulations and/or best practices standards) **contained in the viewable portion, e.g., body, subject line, etc., of the message, or any known type of "flag". In one embodiment, the message-type specifier is a data string, such as an alphanumeric or ASCII character string, stored in a special field of the message's header information. Such header information is typically hidden from the recipient**. The concept of inclusion of such a special field in the header information to provide a message-specific message-type specifier is within the scope of the present invention."

[0025] For example, the message type specifier may be indicative of content of the electronic mail message, e.g., **if the message is of a personal, confidential nature, the specifier may be "CONFIDENTIAL", if the message relates to newsletters, the specifier may be "NEWS", if it relates to the billing statements, it may be "BILLS"; if it relates to advertising, the specifier may be "ADV"**. For example, **the message type specifier may be assigned by affirmative action of the sender, e.g., by typing the specifier in the subject or body of the message**. This requires no special software on the part of the sender. Alternatively, **the specifier may be assigned to and associated with a message, e.g., by storing it in the message, in an automated way by dynamic specifier generator software 180 stored at the sender's computer** and including any suitable logic for doing so. For example, this may be incorporated into the mail composition software. Preferably, the mail type specifier is associated with the message by storing the mail type specifier in header information of the electronic mail message. For example, the dynamic header generator 180 may scan text of the message and associate an appropriate keyword with the message. Alternatively, **the author of the mail message may specify a mail type specifier to be associated with the message**, e.g., by selection from a menu, the associating being performed by the dynamic header generator 180. Programming techniques for carrying out these steps are well known in the art."

[0030] Steps 28-34 of FIG. 2 are illustrative of the processing shown at step 18 in FIG. 1. As shown at step 28 in FIG. 2, **a rule associated with the message type specifier is identified. The rule controls how the e-mail message will be processed**. For example, **the rule may be contained with the message. Alternatively, the recipient's communications device may communicate via a communications network to obtain a copy of the rule from a central source, such as a third party trusted intermediary**. In this example, the rule is obtained from a data store of rules 155 stored in a memory of the recipient's communications device. **Such a data store is preferably periodically updated by a third party trusted intermediary** responsible for defining rules, maintaining and updating rules, approving proposed rules, and distributing such rules to senders and recipients known to the trusted intermediary."

Applicants respectfully submit that the message type specifier of Schiavone is associated with an incoming mail message <u>by a sender or by the author of the message,</u> <u>prior</u> to receipt of the message by the recipient. Thus, the recipient only identifies the <u>previously</u> associated message type specifier upon receiving the message. Schiavone makes no reference to an incoming email message being indicated by a level of preference at the recipient (the alleged mobile station). In other words, no level of preference is indicated **by the recipient,** but rather the message type specifier is associated with an incoming mail message **before** the message is received by the user.

Furthermore, Schiavone, in pertinent part, discloses (emphasis added):

[0055] In this example, the **sender stores aggregate preference data**, e.g. **in an aggregate preference data store** 160 as shown in FIG. 6. Such aggregate preference data is periodically transmitted from a third party intermediary, e.g., a trusted third party, which receives preference data from individual recipients, collates the data, and periodically transmits the data to senders known to the third party intermediary. Implicitly, this step involves receiving aggregate recipient preference data reflecting each of a plurality of recipients' preferences relating to mail messages having certain characteristics."

[0066] "In accordance with an alternate embodiment of the present invention, the rule base 155 may also or alternatively be stored at the commercial mailer, trusted authority and/or another third party and referenced as necessary via a communications network. In another alternate embodiment, **a recipient compliance engine may reside at**

commercial mailer, trusted authority and/or another third party to perform the processing of the rules and collection of recipient preference data, as necessary.

[0007]: Compliance is determined as a function of **user preferences stored in a recipient data store, e.g., at a client device, sender device, or an intermediary's device, such as a trusted authority's device**.

Schiavone, at best, discloses **comparing a message type specifier** of a received message with **predetermined recipient preferences** (which are stored in a recipient's profile) to check whether the recipient has indicated a willingness to receive messages with the message type. Clearly, Schiavone does not disclose that a recipient, or any mobile station, determines to indicate an electronic mail message by a level of preference of the electronic mail message.

In addition, the secondary reference to Martin does not cure the above deficiencies of Schiavone. For example, Martin, at best, merely describes providing a listing or index of message summaries that satisfy a particular category of the subscriber index criteria table (see, Martin, col. 14, lines 56-58), while being completely silent as to how the subscriber index criteria is created.

With respect to independent claims 16, 31, and 34, Applicants respectfully submit that Schiavone and Martin fail to disclose or render obvious "determining to process the electronic mail message for resulting in an order of preference for electronic mail messages for a user of a mobile station," as recited in independent claim 16, and as similarly recited in independent claims 31 and 34.

In the statement of rejection, as best understood, the Office Action alleges that paragraph [0007] of Schiavone discloses the above discussed features. Applicants respectfully disagree.

Schiavone, in pertinent part, discloses (emphasis added):

[0007] The present invention provides a system and method for rule-based **processing** of electronic mail messages. The rules include logic for **processing** of incoming messages. A common set of rules is used by two or more users of the system. **The rule may be associated with messages by default, in an automated fashion, or as the result of a sender's specification, e.g.,** by including a mail-type specifier in the message. In this manner, logic for **processing** a message may be separated from the message itself, allowing diverse communications between diverse parties in accordance with a single rule.

[0066] In accordance with an alternate embodiment of the present invention, the rule base 155 may also or alternatively be stored at the commercial mailer, trusted authority and/or another third party and referenced as necessary via a communications network. In another alternate embodiment, a recipient compliance engine may reside at commercial mailer, trusted authority and/or **another third party to perform the processing of the rules and collection of recipient preference data, as necessary**.

The processing described in paragraph [0007] of Schiavone is merely referring to rule-based processing of electronic mail messages.   The rules described by Schiavone are not remotely related to an **order of preference** for an electronic mail message.   Furthermore, paragraph [0060] of Schiavone, at best, merely describes a recipient compliance verification that is performed by a third party.

The secondary reference to Martin does not cure the above deficiencies of Schiavone. For example, Martin, in pertinent part, discloses (emphasis added):

Col. 15, lines 55-60: Automatically, through index criteria table 1020 or as specified by the message received **from subscriber**. 120, translating controller 205 determines that subscriber 120 has requested **a message index and prompts message controller 210 to transfer subscriber message index** 1030 to subscriber 120 (process step 1115).

Martin, at best, describes transferring a subscriber message index, wherein the subscriber message index (as defined by martin at the Abstract) is "a condensed summary of one or more of the messages directed to the subscriber."   Applicants respectfully submit that a condensed summary of one or more messages cannot reasonably be considered as corresponding to an **order of preference** for electronic mail messages.

It is therefore apparent that even if the applied references are combined as proposed by the Office Action, and Applicants do not agree that the requisite basis to support the asserted motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp, 837 F.2d 1044 (Fed. Cir. 1988).* Thus, for at least the above, reasons, Schiavone and Martin fail to disclose or render obvious all of the features of claims 1, 10-13, 15, 16, 17, 26-28, and 30-34.

Therefore, independent claims 1, 16, 17, and 31-34 are patentable over Schiavone and Martin. Dependent claims 10-13, 15 and 26-28, and 30, also are patentable for at least the reasons independent claims 1 and 17 patentable, from which these claims variously depend, as well as for the additional features these claims recite. Accordingly, withdrawal of the rejection is respectfully requested.

35 U.S.C. § 103(a) rejections of claims 2-9, 14, 18-25, and 29 over Schiavone in view of Martin, and further in view of Horvitz (US 2004/0172457) (Horvitz) or over Schiavone in view of Martin, and further in view of Tarnanen et al. (US 6,834,196) (Tarnanen).

Horvitz and Tarnanen at least fail to cure the deficiencies of Schiavone and Martin. Therefore, claims 2-9, 14, 18-25, and 29 also are patentable over the combination of Schiavone and Martin, for at least the reasons independent claims 1 and 17 are patentable, from which they variously depend, as well as for the additional features these claims recite. Accordingly, withdrawal of the rejections is respectfully requested.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the

undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

February 14, 2011   /Phouphanomketh Ditthavong/
Date   Phouphanomketh Ditthavong
                         Attorney/Agent for Applicant(s)
                         Reg. No. 44658

                         Lenwood Faulcon, Jr.
                         Attorney/Agent for Applicant(s)
                         Reg. No. 61310

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9951
Fax (703) 519-9958